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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,391	07/25/2001	Hideo Ando	211260US2SDIV	4764
22850	7590	11/04/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SHIBRU, HELEN	
		ART UNIT	PAPER NUMBER	
		2616		

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/911,391	ANDO ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	HELEN SHIBRU	2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 25 July 2001.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 30-46 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 30-46 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 25 July 2001 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

***Information Disclosure Statement***

1. The information disclosure statement filed on 4/27/2005 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered. The translation of this IDS must be submitted.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 30-32 and 45-46 are rejected under 35 U.S.C. 101 because the claims are directed to a recording medium storing nonfunctional descriptive material.

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are neither physical “things” nor statutory processes. See, e.g. Warmerdam, 33 F. 3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory) and merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. See MPEP 2106.IV.B.1.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 30-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim (US Pat. No. 6, 766, 103).

Regarding claim 30, Kim discloses an information storage medium (see fig. 1 DVD (1)) having an information recording area which includes a management information recording area and at least one object recording area (see col. 3 lines 19-43),

said management information recording area being configured to describe at least one index point within said object recording area (see col. 3 line 44-col. 4 line 13).

Regarding claim 33, Kim discloses a recording apparatus configured to perform information recording on the medium of claim 30 (see fig. 1 writing signal processor (8), controller (6), user input device, memory (7), and col. 3 lines 24-42 and col. 4 lines 4-42).

Regarding claim 36, Kim discloses a reproducing apparatus configured to perform an information reproduction from the medium of claim 30 (see col. 5 lines 5-25).

Claims 39 and 42 are method claims corresponding to the apparatus claims 33 and 36 respectively. Therefore claims 39 and 42 are analyzed and rejected for the same reason as discussed in claims 33 and 36 above.

Regarding claim 31, Kim discloses an information storage medium having an information recording area which includes a management information recording area and at least an audio object recording area configured to record a tune or music in unit of a track (see fig. 1 DVD (1), col. 4 lines 14-23 and col. 5 lines 55-59),

said management information recording area being configured to describe an index point within said audio object recording area, and to describe an entry point of the track defined by a user (see col. 3 lines 16-43 and col. 5 lines 37-54), and

    said index point corresponding to a head of the tune or music being able to indicate a head of the track defined by a user (see col. 3 lines 16-43 and col. 4 lines 24-33, pointers, start and end points).

Regarding claim 32, Kim discloses entry point of the track defined by a user can be represented by said index point, provided that a specific part of the track is defined as a segment, said segment is indicated by an index, and a start point of the segment indicated by said index is specified by said index point (see col. 4 lines 7-42).

Claims 34 and 35 are analyzed and rejected for the same reason as described in claim 33 above.

Claims 37 and 38 are analyzed and rejected for the same reason as described in claim 36 above.

Claims 40 and 43 are method claims corresponding to the apparatus claims 34 and 37 respectively. Therefore claims 40 and 43 are analyzed and rejected for the same reason as discussed in claims 34 and 37 above.

Claims 41 and 44 are method claims corresponding to the apparatus claims 35 and 38 respectively. Therefore claims 41 and 44 are analyzed and rejected for the same reason as discussed in claims 35 and 38 above.

Regarding claims 45 and 46, the limitations of claims 45 and 46 can be found in claims 31 and 32 above. Therefore claims 45 and 46 are analyzed and rejected for the same reason as discussed in claims 31 and 32 above.

***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 30, 33, 36, 39, and 42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,658, 200. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons set forth below.

The subject matter of claim 1 can be found in patent claim 1. Patent claim 1 recites an information recording medium comprising: an audio information recording area for recording audio information; and a management area for recording management information with respect to the recording area, wherein, said information medium is constructed so as to be able to record not only said audio information but also other information, said management area is constructed

so as to be able to further record management information with respect to information other than said audio information, related information about the audio information and information other than the audio information during reproducing is stored in said management area, said management area includes cell information containing entry point information, and said entry point information is configured to include: entry point type information indicating a type of an entry point, entry point time information, and index information configured to specify a head of part of said audio information.

The subject matter of claim 33 can be found in the patent claim 4.

The subject matter of claim 36 can be found in the patent claim 5.

The subject matter of claim 39 can be found in the patent claim 2.

The subject matter of claim 42 can be found in the patent claim 3.

8. Claims 31, 32, 34-35, 37-38, 40-41, 44-46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6, 658, 200 in view of Kim (US Pat. No. 6, 766, 103).

Regarding claim 31, the subject matter of this claim can be found in claim 1 of Patent 6, 658, 200. However Patent 6, 658, 200 fails to claim specifically an audio object recording area configured to record a tune or music in unit of a track, an entry point of the track defined by a user, and index point indicates a head of the track defined by a user.

In the same field of endeavor, Kim discloses an information storage medium (see fig. 1 DVD (1)) configured to record audio objects in a unit of track (see col. 4 lines 14-23 and col. 5 lines 55-59). Kim further discloses an entry point of the track defined by a user (see col. 3 lines 16-43 and col. 5 lines 37-54). Kim further discloses index point indicates a head of the track

defined by a user (see col. 3 lines 16-43 and col. 4 lines 24-33, pointers, start and end points).

Therefore it would have been obvious to one skill in the art at the time the invention was made to modify claim 1 of Patent 6,658,200 using Kim in order to receive user's command.

Regarding claim 32, claim 32 is analyzed and rejected for the reasons as discussed in claim 31 above.

The subject matter of claims 34 and 35 can be found in the patent claim 4 and rejection of claim 31 above.

The subject matter of claims 37 and 38 can be found in the patent claim 5 and rejection of claim 31 above.

The subject matter of claims 40 and 41 can be found in the patent claim 2 and rejection of claim 31 above.

The subject matter of claim 44 can be found in the patent claim 3 and rejection of claim 31 above.

9. Regarding claims 45 and 46, the limitations of claims 45 and 46 can be found in claims 31 and 32 above. Therefore claims 45 and 46 are analyzed and rejected for the same reason as discussed in claim 31 above.

### *Conclusion*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES J. GROODY can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Helen Shibru  
October 26, 2005

*Robert Chevalier*  
ROBERT CHEVALIER  
PRIMARY EXAMINER